

REMARKS

In the Advisory Action dated February 13, 2004, the Examiner refused to enter Applicant's amendments of February 2, 2004, asserting that they necessitated a new search. Accordingly, Applicant resubmits the claim amendments previously introduced in the February 2, 2004 response concurrently with a Request for Continued Examination. Reconsideration is respectfully requested in light of the amendments and accompanying remarks.

The Examiner has maintained the rejection of claim 26 under 35 U.S.C. § 102(e) as being anticipated by the patent to Olgilvie. Respectfully, Applicants amend claim 26 and traverse the rejection. The patent to Olgilvie does not teach each element of amended claim 26 as is required to uphold a rejection under § 102.

Applicants' invention relates to a system and method of controlling the retransmission (e.g., replies and forwards) of email message content by a recipient of the email message. By way of example, a sender transmits a first email message to a recipient. Included with the first email message is control information that controls the retransmission of a selected portion of the first email message by the recipient. The selected portion of the first email message may be, for example, selected text, an attachment, or the entire email message. Upon receipt, the recipient may freely reply to or forward the first email message in a second email message. However, the control information determines whether the selected portion of the first email message is included with (or excluded from) the second email message when the recipient replies to or forwards the first email message.

A reply or forward originating from the recipient is, as is well understood by those skilled in the art, a separate email message that includes a copy of the contents of the first email message. By controlling inclusion/exclusion of content into this second email message, the present invention controls retransmission while leaving the recipient's (original) copy undeleted. To clarify this aspect of the invention, Applicants have amended claim 26 without adding new matter to now require, "inserting control information into a first email message to control

retransmission of the email message content in a second email message originating from a recipient of the first email message, without deleting the recipient's copy of the first email message."

Contrast this requirement of amended claim 26 with the patent to Olgilvie. Olgilvie discloses an executable code block sent with an email message or resident on a recipient's system that deletes the recipient's copy of the email message responsive to a pre-configured trigger (Olgilvie, cols. 5–7). However, the self-removing code in Olgilvie never controls retransmission of the messages without deleting the recipient's copy of the email message as required by claim 26. Instead, it permanently deletes the email message content from the recipient's system upon the occurrence of a pre-configured trigger (Olgilvie, col. 9, ln. 63 – col. 10, ln. 3). According to Olgilvie, this prevents the accumulation of unwanted emails on the recipient's computer, and lifts the burden of disposal from the recipient (Olgilvie col. 2, ll. 16-31).

Indeed, the deletion of the recipient's copy of the email from the recipient's system is fundamental to the Olgilvie system. While the recipient may reply to or forward the email message without deleting the recipient's copy before the trigger fires (i.e., the copy remains unaltered on the recipient's system), there is never any attempt to control retransmission during this period. The recipient may reply to or forward the message without bounds (Olgilvie, col. 6, ll. 10–13). Once the trigger fires, however, the self-removal code deletes the recipient's copy of the email message from the recipient's system. The Examiner appears to indicate that this removal is the same as controlling retransmission. Applicants respectfully disagree. However, if Olgilvie could be construed as the Examiner asserts (which it cannot), then the only way that Olgilvie can control retransmission is by necessarily deleting the recipient's copy of the message. Once deleted, there is no message for the recipient to reply to, no message for the recipient to forward, and as a natural consequence, no message to control retransmission of.

Anticipation under 35 U.S.C. §102 requires the disclosure of each and every limitation of a claimed invention in a single piece of prior art. *Rockwell Inter. Corp. v. U.S.*, 147 F.3d 1358,

47 U.S.P.Q.2d 1027 (Fed. Cir. 1998). However, the patent to Olgilvie fails to teach, "inserting control information into a first email message to control retransmission of the email message content in a second email message originating from a recipient of the first email message, without deleting the recipient's copy of the first email message," as required by claim 26.

Because the Olgilvie patent does not teach each and every limitation of claim 26, it necessarily fails to anticipate claim 26 under § 102. Accordingly, Applicants respectfully request the allowance of claim 26, and its dependent claims 27-35.

The Examiner also maintained the § 102(e) rejection of claims 36, 42, 52, 57, and 63 over Olgilvie, and cited reasons similar to those stated above with respect to claim 26. However, Applicants have also amended claims 36, 42, 52, 57, and 63 to include language similar to that of amended claim 26 discussed above. Therefore, for the reasons stated above with respect to claim 26, Olgilvie fails to anticipate any of claims 36, 42, 52, 57, and 63, as well as all of the claims that depend therefrom.

The Examiner also rejected dependent claim 35 under 35 U.S.C. § 103(a) as being unpatentable over Olgilvie in view of Foladare. The Examiner admits that Olgilvie fails to teach or suggest claim 35, but asserts that the patent to Foladare does. Respectfully, this assertion is incorrect. Claim 35 depends directly from claim 26, and thus, necessarily includes all the limitations of claim 26. Claim 35 requires the control information sent with the email message to cause "at least a portion of the email message content to be excluded from the second email message based on the identity of the recipient." Foladare, in contrast, does nothing of the sort.

In Foladare, a centralized email server in the network receives an email message from a sender, and then determines which portions of the message to send on to the recipient (Foladare, col. 1, ll. 31-34). This decision, however, is not based on "the identity of the recipient," as required by claim 35, but rather, is based on the amount of data that receiving equipment can handle. Column 3 of Foladare, lines 40-54 reveal (emphasis added).

The portions of the electronic mail message sent to the electronic mail receiving devices 120-150 depends on the portions identified in the profile information retrieved and the amount of data that the device is able to receive and display. For example, if one of the electronic mail receiving devices 120-150 is an alpha pager, because of the limited display size, the portions of the electronic mail message that are sent to the alpha pager may be limited to the sending party name, title of the message, and time and date of sending. On the other hand, if one of the electronic mail receiving devices 120-150 is a personal digital assistant (PDA) or personal computer, for example, the entire electronic mail message may be sent to the PDA or personal computer.

Further, the centralized server of Foladare does not use "control information inserted into the first e-mail message," but in contrast, must retrieve profile data stored in a database attached to the centralized server. "Based on the information retrieved from the profile database 165, the centralized electronic mail device 160 sends portions of the electronic mail message stored in memory to the designated electronic mail receiving devices 120-150." Foladare, col. 3, ll. 36-39. Besides, whatever Foladare teaches with respect to email content inclusion relates only to the delivery of the original (first) email message to the recipient, not a "second email message originating from the recipient" as required by claim 35. Indeed, any of the disclosed operations in Foladare occur before the recipient ever receives the email message from the centralized server, and thus, the recipient necessarily cannot reply to or forward in "the second email message."


To sustain this rejection, the argued-for combination of Olgilvie and Foladare must teach or suggest every limitation of the rejected claims. Notably, the Examiner carries the initial burden of making out a prima facie case of obviousness. If the Examiner fails to show that the cited combination teaches the invention as claimed the obviousness rejection fails as a matter of law. Here, neither Olgilvie nor Foladare teach or suggest that the control information inserted into the first email message "causes at least a portion of the email message content to be excluded from the second email message based on the identity of the recipient." Because neither Olgilvie nor Foladare alone teach or suggest claim 35, it necessarily follows that the

combination of Olgilvie and Foladare cannot teach or suggest claim 35. Accordingly, Applicants respectfully request that the § 103 rejection of claim 35 be withdrawn.

Finally, the Examiner rejected dependent claims 41, 51, 62, and 68 over the same art and for the same reasons cited above with respect to claim 35. However, claims 41, 51, 62, and 68 all recite language similar to that contained in claim 35. For the reasons stated above, neither Olgilvie nor Foladare teach or suggest, alone or in combination, any of dependent claims 41, 51, 62, and 68. Accordingly, Applicants respectfully requests the allowance of claims 41, 51, 62, and 68.

Respectfully submitted,

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